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FULBRIGHT & JAWORSKI, LLP  
1301 MCKINNEY  
SUITE 5100  
HOUSTON, TX 77010-3095

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/912,621

Applicant(s)

MILLIORN ET AL

Examiner

Walter B Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-23, drawn to an adhesive label, classified in class 428, subclass 40.1.
  - II. Claims 24-28, drawn to a conversion process for forming triangular shaped labels, classified in class 156, subclass 249.
2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product such as square shaped labels.
3. During a telephone conversation with Jan K. Simpson on October 3, 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Specification***

6. The disclosure is objected to because of the following informalities: The numbering of the paragraphs in the specification (e.g. [0001]) is improper and should be deleted.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 3, 5, 8, 9, 11, 12, 14-16, 18-20, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "triangular shaped" in claims 1 and 15 is a relative term which renders the claim indefinite. The term "triangular shaped" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In regard to claims 3 and 16, "vinyl" and "foil" are indefinite terms. The composition intended to recited by these terms is not clear.

In regard to claims 5 and 18, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so

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perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Furthermore, the word “easily” is indefinite.

In regard to claims 8, 9, 11, 12, 15, 19, 20, 22 and 23, the recitations that the text is related to text used in food safety labeling systems are intended use phrases that are not given patentable weight, since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987).

In regard to claims 9 and 20, “FIFO” must be written out in full, unabbreviated form.

In regard to claim 14, the phrase “a variable copy position for the text results in text being positioned” seems to be a process limitation. A proper article claim would recite solely the positioning of the text on the labels.

In regard to claim 15, it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther.

In regard to claim 1, Oosterlinck teaches a method and apparatus for converting label base stock 10 to releasably-lined labels, the base stock having a face web 12, a backing liner 16 and adhesive layer 14 in between face web 12 and backing liner 16 (col. 3, lines 27-33, col. 6, lines 46-50 and Figure 1). A continuous supply of base stock 10 is fed into the label conversion apparatus where the base stock travels in the direction indicated by the arrows drawn inside rollers 22, 24, 26 and 38 in Figure 2 (col. 3, lines 50-67). Labels are cut from face web 12 and are imprinted (col. 3, lines 53-58). Oosterlinck teaches the formation of a roll of labels at rewind mandril 28 (col. 6, lines 29-31 and Fig. 2).

In regard to claims 1 and 2, Oosterlinck fails to teach the step of configuring a plurality of triangular shaped labels on the face material in which each label has a first, second and third side wherein the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width. In regard to claim 2, Oosterlinck fails to teach adjacent rows of triangular shaped labels positioned parallel to the web direction. However, Warther discloses a modified sheet product 110 that holds triangular-shaped tag elements (items 50A-50X) that are configured such that the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width in order to maximize the number

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of tag elements which may be provided on a sheet product of a given size (col. 3, lines 33-41 and Figure 3). Warther also discloses adjacent rows of the triangular shaped tags in Figure 3.

Therefore, one of ordinary skill in the art would have recognized to have constructed the labels of Oosterlinck in the triangular shaped form of the tags of Warther and to have configured the triangular shaped labels such that the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width in order to maximize the number of elements which may be provided on a sheet product of a given size as taught by Warther.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the labels of Oosterlinck in the triangular shaped form of the tags of Warther and to have configured the triangular shaped labels such that the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width in order to maximize the number of elements which may be provided on a sheet product of a given size as taught by Warther.

In regard to claim 3, Oosterlinck teaches that the face web is made of a flexible material such as paper or plastic (col. 4, lines 6-7). Note that polyester, vinyl, polypropylene and plastic foil are all plastics.

In regard to claim 4, Oosterlinck teaches that the adhesive is selected according to the intended end use of the label by considering the length of time the label is intended to be affixed to an article and the temperature or other environmental conditions to which the label will be exposed (col. 4, lines 9-14). Thus, each of the four claimed types of adhesive (permanent, removable, water-soluble and cold temperature) are taught by Oosterlinck.

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In regard to claim 5, Oosterlinck teaches that the backing liner 16 includes a silicone coating release layer 18 that allows the backing liner 16 to release from the face web 12 (col. 4, lines 15-20 and Figure 1).

In regard to claim 6, Oosterlinck teaches the collection of waste matrix material subsequent to die cutting of the labels (col. 2, lines 41-43).

In regard to claim 7, Oosterlinck teaches that a design or other label information is printed on the front surface of the label (col. 5, lines 31-36). Examiner interprets "other label information" to denote text, inter alia.

11. Claims 8 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther, and in further view of Kirk.

In regard to claim 8, Oosterlinck and Warther teach the triangular shaped label as discussed above. Oosterlinck and Warther fail to teach that the text printed on the plurality of labels is related to text used in food safety labeling systems. However, Kirk teaches that it is necessary that the container for particular food products include information such as the name of the product, the ingredients of the food product, the batch or lot number of the food product, the expiration date for use of the product and instructions relating to the dispensing and use of the product (col. 1, lines 20-27). One of ordinary skill in the art would have recognized to include this food safety information taught by Kirk on the triangular shaped label taught by Oosterlinck and Warther in order to convey necessary food safety information, as it is notoriously well known to include food safety information on food labels as taught by Kirk.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have to included the food safety information taught by Kirk on the triangular shaped

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label taught by Oosterlinck and Warther in order to convey necessary food safety information, as it is notoriously well known to include food safety information on food labels as taught by Kirk.

In regard to claims 15-19, Oosterlinck, Warther and Kirk teach the triangular shaped label as discussed above. Oosterlinck, Warther and Kirk fail to teach that the triangular shaped label has sides of equal length. However, since Warther teaches configuration of the labels on a sheet so as to maximize the number of tag elements which may be provided on a sheet product of a given size, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the labels of Warther so that the sides of the triangular shaped label are of equal length in order to further maximize the number of tag elements which may be provided on a sheet product of a given size. For example, modification of the length of the sides of labels in the form of tags 50A-50X of Warther such that each of the sides are the length of the shortest side of tags 50A-50X of Warther would allow for a fourth row of labels in sheet 110 in Figure 3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the labels of Warther so that the sides of the triangular shaped label are of equal length in order to further maximize the number of tag elements which may be provided on a sheet product of a given size.

12. Claims 9 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther, and in further view of Kirk, and in further view of admitted prior art of Applicants (specification, page 1, paragraph [0003]).

In regard to claims 9 and 20, Oosterlinck, Warther and Kirk teach the triangular shaped label as discussed above. Oosterlinck, Warther and Kirk fail to teach that the text consists of text

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found in day of the week FIFO food safety labeling systems, text relating to shelf-life/product identification food safety labeling systems and text relating to use by/use first food safety labeling systems. However, Applicants disclose that these three food safety labeling systems are notoriously well known to those of ordinary skill in the food labeling art in paragraph [0003] of the "Background of the Invention" section of Applicants' specification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided text consisting of text found in day of the week FIFO food safety labeling systems, text relating to shelf-life/product identification food safety labeling systems and text relating to use by/use first food safety labeling systems to the label of Oosterlinck, Warther and Kirk since it is notoriously well known to provide text consisting of text used in the aforementioned food safety labeling systems as taught by the admission of Applicants.

In regard to claims 21-23, Oosterlinck, Warther and Kirk fail to teach that printing the plurality of labels includes printing color on the plurality of labels (in regard to claim 21), that the color is related to an industry standard color code system used in food safety labeling systems (in regard to claim 22) and the particular colors corresponding to the days of the week in the industry standard color code system (in regard to claim 23). However, Applicants disclose that it is notoriously well known to those of ordinary skill in the art to use the industry standard color code system used in food safety labeling systems. Afterall, the color code system is described as "industry standard" by Applicants. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided color to the labels of Oosterlinck and Warther according to the industry standard color code system used in food safety labeling systems since it is notoriously well known to apply colors to labels according to the industry

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standard color code system used in food safety labeling systems as taught by the admission of Applicants.

13. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther, and in further view of admitted prior art of Applicants (specification, page 1, paragraph [0003]).

Oosterlinck and Warther teach the triangular shaped label as discussed above.

Oosterlinck and Warther fail to teach that printing the plurality of labels includes printing color on the plurality of labels (in regard to claim 10), that the color is related to an industry standard color code system used in food safety labeling systems (in regard to claim 11) and the particular colors corresponding to the days of the week in the industry standard color code system (in regard to claim 12). However, Applicants disclose that it is notoriously well known to those of ordinary skill in the art to use the industry standard color code system used in food safety labeling systems. Afterall, the color code system is described as “industry standard” by Applicants. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided color to the labels of Oosterlinck and Warther according to the industry standard color code system used in food safety labeling systems since it is notoriously well known to apply colors to labels according to the industry standard color code system used in food safety labeling systems as taught by the admission of Applicants.

14. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther, and in further view of admitted prior art of Applicants (specification, page 3, paragraph [0009]).

Oosterlinck and Warther teach the triangular shaped label as discussed above.

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In regard to claim 13, Oosterlinck and Warther fail to teach that the printing on the plurality of labels further includes the step of positioning text on each of the triangular labels such that the text on each triangular label is oriented in the same direction. However, Applicants disclose that it is customary to print text on labels with a specific orientation to the shape of the label in paragraph [0009] of the "Background of the Invention" section of Applicant's specification, for instance, one accepted copy position is disclosed to be the "bottom" of the label. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have positioned text on each of the labels such that the text on each label is oriented in the same direction, since it is notoriously well known to do so as taught by the admission of Applicants.

In regard to claim 14, Oosterlinck and Warther fail to teach a variable copy position for the text which results in the text being positioned on alternating first and second sides of adjacent triangular labels. Since Applicants disclose in paragraph [0009] of the "Background of the Invention" section of Applicant's specification that the labels with text in a set location on each label are often oriented in the same position on the liner so that the labels are applied with minimal handling once it is removed from the roll of labels, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have oriented the text on alternating first and second sides of the labels oriented in the arrangement taught by Warther in order to minimize the amount handling required after the labels are removed from the roll of labels prior to application of the labels since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

**Conclusion**


15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. 4,787,158 to Vitol (see col. 5, lines 40-48), U.S. 6,179,337 to Zumberge (see Figure 5) and U.S. 6,127,013 to Todd (see col. 9, lines 18-20).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba wba  
10/21/02

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

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